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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,787	06/26/2003	Richard D. Lee	FINEL:63549	6894

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EXAMINER

WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,787

Applicant(s)

LEE ET AL.

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/04 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5-7, 10-12, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Polakowski (US 6,135,834). Regarding claim 1, First conduit (82) has port side outlet at port side sponson (32). Second conduit (80) has starboard side outlet at starboard side sponson (34). Both conduits are connected to exhaust manifold (164) (see figure 11). Valve means (86 and 92) for directing the exhaust are connected to the conduits. The valve means comprises first valve (92) connected to the first conduit (82) and second valve (86) connected to the second conduit (80). Valve means also comprises a means for linking the valves together so that opening of one causes closing

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of the other such that more exhaust is directed to one side of the boat than the other.

Means for linking comprises link (170). Specifically, valve (86) has moveable member (104) and valve (92) has moveable member (112). Starting with the linkage in the center (or neutral position), moving of the linkage (170) clockwise closes one moveable member (104) while leaving the other (112) in the open position. Starting with the linkage in the center (or neutral position), moving of the linkage (170) counter clockwise closes moveable member (112) while leaving member (104) open. But starting with the linkage (170) in the fully rotated clockwise position, and rotating it through center (i.e. neutral) to the fully rotated counterclockwise position takes the valves from the state of member (104) open and member (112) closed to the state of member (104) closed and member (112) open. Therefore, the linkage is opening the first member (112) and closing member (104). Therefore, the linkage (170) constitutes a means for linking the valves such that opening one closes the other.

4. Regarding claim 2, the conduits include connecting portions (166, 168). Figure 11 shows a 90° connection between the conduits (166, 168) and the manifold (164)

5. Regarding claim 5, the means for linking comprises mechanical linkage (170) between the valves.

6. Regarding claim 6, valve control means comprises handle bar (38) and cable (60). The control means directs more exhaust to one side or the other of the boat.

7. Regarding claim 7, the means for linking comprises mechanical linkage (170). Handlebar (38) and cable (60) are a mechanical control that is connected to the linkage for controlling the valves.

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8. Polakowski as described above with respect to claims 1, 2, and 5-7 contains all of the recited elements of claims 10-12 and 14-16. Claim 10 recites "such that directing the engine exhaust out of one of the exhaust outlets prevents directing the engine exhaust out of the other of the exhaust outlets". Polakowski has at least one mode of operation that satisfies this claim limitation. In Polakowski, when the linkage is in the full rotated clockwise position, the apparatus is directing engine exhaust out of one exhaust outlet and preventing the engine exhaust from being directed out of the other outlet.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 13, 8, 9, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polakowski (US 6,135,834). Regarding claims 4 and 13, Polakowski does not disclose that the embodiment of figure 11 can be used with electrically controlled valves and an electrical switch. Polakowski does disclose that an earlier embodiment (figure 8) can utilize either mechanical valves and controller or electrical valves and control electronics including a switch (column 7, lines 20-40). Based upon the teaching of equivalence in the earlier embodiment, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the embodiment of figure 11 by using electrical valves and control electronics. Polakowski

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teaches that a major advantage (i.e. motivation) is the ability to electrically control the valves.

11. Regarding claims 8, 9, 17, and 18, claims 8 and 17 recite "controlling a flow of engine exhaust to permit the flow of engine exhaust through one of the first and second exhaust conduits, such that directing the engine exhaust out of one of the exhaust conduits prevents directing the engine exhaust out of the other of the exhaust conduits". Polakowski has at least one mode of operation that satisfies this claim limitation. In Polakowski, when the linkage is in the full rotated clockwise position, the apparatus is directing engine exhaust out of one exhaust outlet and preventing the engine exhaust from being directed out of the other outlet. Further regarding claims 8 and 17, Polakowski does not explicitly disclose the recited method steps. The steps, however, are inherent in the making and use of the Polakowski apparatus as described above. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon the making and use of the Polakowski apparatus. The motivation would be to use the Polakowski apparatus.

12. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffiths et al. (US 6,299,496). Griffiths discloses a method for directing a boat's engine exhaust. The boat comprises a first conduit (68) and a second conduit (80). The method comprises controlling a flow of engine exhaust to permit flow of exhaust through the second conduit by closing the first conduit with a valve (20), such that directing the

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exhaust through the second conduit prevents directing exhaust out of the first conduit.

Griffiths does not explicitly disclose the recited method steps. The steps, however, are inherent in the making and use of the Griffiths apparatus as described above.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon the making and use of the Griffiths apparatus. The motivation would be to use the Griffiths apparatus.

13. It is noted that claims 8 and 17 have numerous structural recitations in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Response to Arguments

14. Applicant's arguments filed 12/21/04 with respect to claims 10-16 have been fully considered but they are not persuasive. Applicant argues that Polakowski does not teach disclose or suggest valve means connected to the conduits for directing exhaust out of one of the outlets "such that directing the engine exhaust out of one of the exhaust outlets prevents directing the engine exhaust out of the other of the exhaust outlets". In response it is noted that Polakowski has at least one mode of operation that

satisfies this claim limitation. In Polakowski, when the linkage is in the full rotated clockwise position, the apparatus is directing engine exhaust out of one exhaust outlet and preventing the engine exhaust from being directed out of the other outlet. Thus, the Polakowski apparatus is directing exhaust to one of the outlets and preventing exhaust from going to the other outlet. Therefore, applicants argument is not persuasive.

15. Applicant's arguments filed 12/21/04 with respect to claims 1, 2, 4-9, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection. It is noted that the arguments regarding claims 4, 5, and 13 were addressed in the Advisory Action dated 1/14/05.

Conclusion

16. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number 571-272-6690. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at 571-272-6684. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 571-273-6690.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

AW 4/15/05
**ANDREW D. WRIGHT
PRIMARY EXAMINER**